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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,495	06/28/2001	Jay S. Walker	01-025	7185

7590 03/25/2004

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EXAMINER

GILLIGAN, CHRISTOPHER L

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/893,495

Applicant(s)

WALKER ET AL. 

Examiner

Luke Gilligan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-45 and 50-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-45 and 50-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Response to Amendment

1. In the amendment filed 1/5/04 in paper number 12, the following has occurred: claims 34, 42, and 50-52 have been amended and claims 54-57 have been added. Now, claims 34-45 and 50-57 are presented for examination.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 52 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

4. The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

5. For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

6. In the present case, claim 52 only recites an abstract idea. The recited steps of merely establishing an agreement with an expert and providing compensation to the expert do not apply, involve, use, or advance the technological arts since all of the recited steps can be

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performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to establish and fulfill a business agreement with an expert.

7. Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claim 52 is deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 34-41, 50 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayaud, U.S. Patent No. 5,845,255 in view of Minder, U.S. Patent No. 6,144,943 and further in view of Echerer, U.S. Patent No. 6,046,761.

10. As per claim 34, Mayaud teaches a method comprising: transmitting, during a time period, a plurality of requests to an expert, wherein each request comprises a request for a diagnosis of a physiological anomaly associated with a patient (see column 19, lines 17-24); and receiving, from the expert, a response to each of the requests, the response to each request being a diagnosis for the patient of the request (see column 20, lines 20-31). Mayaud do not explicitly teach establishing an agreement with the expert, wherein the agreement specifies a periodic compensation amount that the expert will receive in exchange for providing a minimum number of diagnoses during a time period, the agreement being unassociated with

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any particular patient; and causing the compensation amount to be provided to the expert if, at the end of the time period, it is determined that the expert has provided the minimum amount of diagnoses during the time period. Mayaud also does not explicitly teach sending the requests electronically.

11. Minder teaches a method for establishing an agreement with an expert (i.e. contract service provider), wherein the agreement specifies a periodic compensation amount that the expert will receive in exchange for providing a minimum number of diagnoses (i.e. grade or score for housekeeping services) during a time period, the agreement being unassociated with any particular customer (see column 3, line 67 – column 4, line 12); and causing the compensation amount to be provided to the expert if, at the end of the time period, it is determined that the expert has provided the minimum amount of diagnoses (i.e. minimum grade) during the time period (see column 4, lines 12-16). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the payment model of Minder into the system of Mayaud based on the tracking of diagnoses performed by physicians. One of ordinary skill in the art would have been motivated to include such a scoring and payment scheme into the system of Mayaud for the purpose of providing an objective measure for determining whether a physician is meeting a predetermined standard (see column 2, lines 25-29 of Minder).

12. Echerer teaches electronically sending requests for diagnosis to experts located in remote locations (see column 5, line 67 – column 6, line 4). It would have been obvious to one of ordinary skill in the art of patient diagnosis at the time of the invention to incorporate this electronic request feature into the system of Mayaud. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of eliminating unnecessary “face to

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face" interaction between patient and doctor and, thereby, reduce costs for both parties (see column 3, lines 13-18 of Echerer).

13. Claim 50 contains substantially similar apparatus limitations to method claim 34 and, as such, is rejected for similar reasons as given above.

14. Claim 51 contains substantially similar method limitations embodied on a computer readable medium to method claim 34 and, as such, is rejected for similar reasons as given above.

15. As per claim 35, Mayaud in view of Minder and Echerer teach the method of claim 34 as described above. Mayaud further teaches selecting the expert from a plurality of remote experts based on a received anomaly and an agreement (see column 21, lines 34-41).

16. As per claim 36, Mayaud in view of Minder and Echerer teach the method of claim 34 as described above. Mayaud does not explicitly teach causing a reduced compensation amount to be provided to the expert if, at the end of the time period, it is determined that the expert has not provided the minimum number of diagnoses during the time period. Minder teaches causing a reduced compensation amount to be provided to the expert if, at the end of the time period, it is determined that the expert has not provided the minimum amount of agreed upon work during the time period (see column 4, lines 41-59). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the invention of Mayaud for the reasons given above with respect to claim 34.

17. As per claim 37, Mayaud in view of Minder and Echerer teach the method of claim 34 as described above. Mayaud does not explicitly teach causing the compensation amount to be withheld from the expert if, at the end of the time period, it is determined that the expert has not provided the minimum number of diagnoses during the time period. Minder teaches causing the compensation amount to be withheld from the expert if, at the end of the time period, it is

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determined that the expert has not provided the minimum amount of agreed upon work during the time period (see column 4, lines 60-63). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the invention of Mayaud for the reasons given above with respect to claim 34.

18. As per claim 38, Mayaud in view of Minder and Echerer teach the method of claim 34 as described above. Mayaud further teach incrementing a stored number of diagnoses provided by the expert during the time period when the diagnosis is received (see column 42, lines 38-53).

19. As per claim 39, Mayaud in view of Minder and Echerer teach the method of claim 38 as described above. Mayaud further teaches determining that the diagnosis provided is associated with at least one factor that indicates a complication in providing the diagnosis (see column 42, lines 38-42); and indicating in the stored diagnoses the at least one factor (see column 42, lines 38-42). In addition, it is assumed that one of ordinary skill in the art would want to give a heavier weight to more complicated diagnoses by flagging. Since the system of Mayaud tracks the number and nature of diagnoses by a particular physician, it is assumed that the more complicated diagnoses could be flagged in the record.

20. As per claim 40, Mayaud in view of Minder and Echerer teach the method of claim 39 as described above. Mayaud further teach the at least one factor that indicates a complication in providing the diagnosis comprises at least one of: i) a greater than average complexity in the anomaly, ii) a greater than average amount of time required to provide the diagnosis, iii) an identification that the expert communicated directly with the patient, and iv) an indication that the patient's life was saved due to the diagnosis (see column 42, lines 38-53).

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21. As per claim 41, Mayaud in view of Minder and Echerer teach the method of claim 40 as described above. Mayaud further teaches providing to the expert, at least once during the time period, an indication of a current number of diagnoses provided (see column 42, lines 50-53).

21. Claims 42-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Echerer, U.S. Patent No. 6,046,761 in view of Weinstein, U.S. Patent No. 5,216,596 and further in view of Platt et al., U.S. Patent No. 5,634,468.

22. As per claim 42, Echerer teaches a method, comprising: establishing an agreement with an entity, wherein the entity agrees to continuously monitor physiological parameters through at least one telemetry device in exchange for compensation (see column 2, lines 18-24 and column 3, lines 32-34); wearing the at least one telemetry device (see column 2, lines 2-4); receiving an indication from the entity that an anomaly has occurred in at least one of the physiological parameters (see column 3, lines 34-43); and receiving a diagnosis based on the anomaly (see column 4, lines 55-58). Echerer does not explicitly teach that the opinion is based on an opinion of at least one expert contacted by the entity in response to at detection of the anomaly. Echerer also does not explicitly teach that the telemetry device is worn "during regular daily activities" and that the anomaly is automatically analyzed by a computing device and an expert is selected and contacted by the computing device based on the analysis.

23. Weinstein teaches obtaining a second opinion from an expert to aid in diagnosis (see column 5, lines 38-46). It would have been obvious to one of ordinary skill in the art of patient diagnosis at the time of the invention to incorporate the second opinion element of Weinstein into the system of Echerer. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of aiding smaller clinics in diagnosing complex problems (see column 3, lines 12-17 of Weinstein).

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24. Platt teaches a patient wears a telemetry device during regular daily activities (see column 1, lines 56-60); and automatically analyzing anomalies by a computing device and selecting and contacting an expert by the computing device based on the analysis (see column 6, lines 8-13). It would have been obvious to one of ordinary skill in the art of patient diagnosis at the time of the invention to incorporate these features into the system of Echerer. One of ordinary skill in the art would have been motivated to incorporate these features for the purpose of reducing the number of trips that a patient must take to the kiosks of Echerer (see column 1, lines 56-60 of Platt).

25. As per claim 43, Echerer in view of Weinstein and Platt teach the method of claim 42 as described above. Echerer further teaches the step of receiving a diagnosis comprises: receiving a diagnosis based on the anomaly, wherein the diagnosis includes at least one instruction regarding an action to be taken in accordance with the diagnosis (see column 6, lines 28-31).

26. As per claim 44, Echerer in view of Weinstein and Platt teach the method of claim 43 as described above. Echerer further teaches wherein the action to be taken comprises: an action to be taken by the entity (see column 7, lines 1-5).

27. As per claim 45, Echerer in view of Weinstein and Platt teach the method of claim 43 as described above. Echerer further teaches the at least one instruction comprises: an instruction to take a medication (see column 6, lines 28-31).

28. As per claim 56, Echerer in view of Weinstein and Platt teach the method of claim 42 as described above. Echerer does not explicitly teach that each request for diagnosis is transmitted after a computing device automatically analyzes a detected anomaly in a physiological parameter of the patient, the anomaly being detected based on a signal received from a telemetry device being worn by the patient. Platt teaches a computing device that

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automatically analyzes a detected anomaly in a physiological parameter of a patient (see column 6, lines 8-13), the anomaly being detected based on a signal received from a telemetry device being worn by the patient (see column 1, lines 56-60). It would have been obvious to one of ordinary skill in the art of patient diagnosis at the time of the invention to incorporate these features into the system of Echerer. One of ordinary skill in the art would have been motivated to incorporate these features for the purpose of reducing the number of trips that a patient must take to the kiosks of Echerer (see column 1, lines 56-60 of Platt).

29. Claims 52-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Echerer, U.S. Patent No. 6,046,761 in view of Minder.

30. As per claim 52, Echerer teaches a method, comprising: establishing an agreement with an entity, wherein the entity agrees to continuously monitor physiological parameters through at least one telemetry device in exchange for compensation (see column 2, lines 18-24 and column 3, lines 32-34). Echerer does not explicitly teach that the agreement specifies a periodic compensation amount that the expert will receive in exchange for electronically providing a minimum number of diagnoses during a time period, the agreement being unassociated with any particular patient at the time of being established; and causing the compensation amount to be provided to the expert if, at the end of the time period, it is determined that the expert has provided the minimum number of diagnoses during the time period.

31. Minder teaches a method for establishing an agreement with an expert (i.e. contract service provider), wherein the agreement specifies a periodic compensation amount that the expert will receive in exchange for providing a minimum number of diagnoses (i.e. grade or score for housekeeping services) during a time period, the agreement being unassociated with any particular customer (see column 3, line 67 – column 4, line 12); and causing the

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compensation amount to be provided to the expert if, at the end of the time period, it is determined that the expert has provided the minimum amount of diagnoses (i.e. minimum grade) during the time period (see column 4, lines 12-16). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the payment model of Minder into the system of Echerer based on the tracking of diagnoses performed by physicians. One of ordinary skill in the art would have been motivated to include such a scoring and payment scheme into the system of Echerer for the purpose of providing an objective measure for determining whether a physician is meeting a predetermined standard (see column 2, lines 25-29 of Minder).

32. As per claim 53, Echerer in view of Minder teach the method of claim 52 as described above. Echerer further teaches providing diagnoses for patients who are remote from an expert (see column 1, lines 40-44) and whose physiological parameters are being monitored by a remote monitoring system (see column 2, lines 2-4).

33. Claims 54 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayaud, U.S. Patent No. 5,845,255 in view of Minder, U.S. Patent No. 6,144,943 and Echerer, U.S. Patent No. 6,046,761 and further in view of Platt et al., U.S. Patent No. 5,634,468.

34. As per claim 54, Mayaud in view of Minder and Echerer teach the method of claim 34 as described above. Mayaud does not explicitly teach that each request for diagnosis is transmitted after a computing device automatically analyzes a detected anomaly in a physiological parameter of the patient, the anomaly being detected based on a signal received from a telemetry device being worn by the patient. Platt teaches a computing device that automatically analyzes a detected anomaly in a physiological parameter of a patient (see column 6, lines 8-13), the anomaly being detected based on a signal received from a telemetry

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device being worn by the patient (see column 1, lines 56-60). It would have been obvious to one of ordinary skill in the art of patient diagnosis at the time of the invention to incorporate these features into the system of Mayaud. One of ordinary skill in the art would have been motivated to incorporate these features for the purpose of reducing the number of trips that a patient must take to the kiosks of Mayaud (see column 1, lines 56-60 of Platt).

35. As per claim 55, Mayaud in view of Minder, Echerer, and Platt teach the method of claim 54 as described above. Mayaud does not explicitly teach determining, by the computing device and based on the analysis of the detected anomaly, that a diagnosis from an expert is required, and selecting at least one expert to provide the diagnosis. Platt teaches determining, by the computing device and based on the analysis of the detected anomaly, that a diagnosis from an expert is required, and selecting at least one expert to provide the diagnosis (see column 6, lines 8-16). It would have been obvious to one of ordinary skill in the art of patient diagnosis at the time of the invention to incorporate these features into the system of Mayaud for the reasons given above with respect to claim 45.

36. Claims 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over Echerer, U.S. Patent No. 6,046,761 in view of Minder and further in view of Platt et al., U.S. Patent No. 5,634,468.

37. As per claim 57, Echerer in view of Minder teach the method of claim 52 as described above. Echerer does not explicitly teach that each request for diagnosis is transmitted after a computing device automatically analyzes a detected anomaly in a physiological parameter of the patient, the anomaly being detected based on a signal received from a telemetry device being worn by the patient. Platt teaches a computing device that automatically analyzes a detected anomaly in a physiological parameter of a patient (see column 6, lines 8-13), the

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anomaly being detected based on a signal received from a telemetry device being worn by the patient (see column 1, lines 56-60). It would have been obvious to one of ordinary skill in the art of patient diagnosis at the time of the invention to incorporate these features into the system of Echerer. One of ordinary skill in the art would have been motivated to incorporate these features for the purpose of reducing the number of trips that a patient must take to the kiosks of Echerer (see column 1, lines 56-60 of Platt).

Response to Arguments

38. In the remarks filed 1/5/04 in paper number 12, Applicants argue in substance that (1) claim 52 as amended overcomes the rejection under 35 U.S.C. 101; (2) the UR agreement of Shults is not "unassociated with any particular patient at the time of being established; (3) neither Echerer nor Weinstein teach that a telemetry device is worn "during regular daily activities; (4) neither Echerer nor Weinstein teach that anomalies are automatically analyzed by a computing device and an expert is selected and contacted by the computing device based on the analysis.

39. In response to Applicants' argument (1), the examiner respectfully submits that the inclusion of the term "electronically" merely defines a term of the agreement established with the expert. Therefore, the Examiner maintains the position that recited steps of merely establishing an agreement with an expert and providing compensation to the expert do not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper.

40. Additionally, Applicants' arguments (2)-(4) have been fully considered by are moot in view of the new grounds of rejection detailed above. In particular, the Examiner now relies upon the teachings of Minder and Platt to teach the newly added features recited in the claims.


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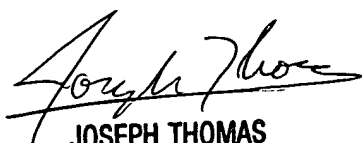
Conclusion

41. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (703) 308-6104. The examiner can normally be reached on Monday-Friday 8am-5:30pm.

42. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703) 305-9588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

43. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


CLG
3/17/04


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